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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,334	11/18/1999	KARI VIRTANEN	PM264014	3837
909	7590	11/03/2004	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			IQBAL, KHAWAR	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/381,334	VIRTANEN, KARI	
	Examiner	Art Unit	
	Khawar Iqbal	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 8-10 and 12 are rejected under 35 U.S.C. 102(e) as being unpatentable by Bertacchi (6097950).
3. Regarding claim 8 Bertacchi teaches a data structure which comprises (abstract, figs. 1-5)

mobile subscriber data in a telecommunications system which supports a first and a second network (col.4, 6-30);

a subscriber-specific access parameter (col. 3, lines 22-25) which indicates whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 3, lines 35-40, col. 4, lines 5-30).

Regarding claim 9 Bertacchi teaches wherein the data structure is located in a home location register of the telecommunications system (col. 8, lines 25-49).

Regarding claim 10 Bertacchi teaches wherein the data structure is located in the memory of the mobile station (col. 8, lines 60-67).

Regarding claim 12 Bertacchi teaches wherein the data structure is located
Subscriber Identity Module of the mobile station (col. 8, lines 60-67).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josse et al (6104929) and further in view of Bertacchi (6097950).

Regarding claim 1 Josse et al teaches a method of registration in a telecommunications system by a mobile station, which system comprises a home location register for maintaining subscriber data and supports a first network, and a second network, the method comprising: (figs. 1-5):

maintaining the mobile subscriber data in the home location register, and sending, from another network element, a message to the home location register for requesting the mobile subscriber data (col.7, lines 23-47, col.6, line 25-col. 7 line 30),

the home location register maintaining an access parameter which indicates whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 8, lines 6-20, col. 6, lines 25-65);

in response to said message for requesting the subscriber data, the home location register sending the mobile subscriber data and also said access parameter (col.7, lines 23-45, col. 8, line 60-col.9, line 10);

the network element that requested the mobile subscriber data using said access parameter for restricting the access of the mobile subscriber only to the first network or to the second network (col.8, lines 6-20, col. 6, lines 49-67, col. 14, lines 25-50). Josse et al does not specifically teach a subscriber-specific access parameter.

In an analogous art, Bertacchi teaches a subscriber-specific access parameter (col. 3, lines 22-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Josse et al by specifically adding features in order to enhance a subscriber-specific access parameter to increasing the efficiency of the communication system for registry procedure as taught by Bertacchi.

Regarding claim 2 Josse et al teaches a method of registration in a telecommunications system by a mobile station, which system comprises home location register for maintaining subscriber data and supports a first network, and a second network, (figs. 1-5) the method comprising:

storing mobile subscriber data in the memory of a mobile station, mobile subscriber data and an access parameter indicating whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 10, lines 45-65, col. 6, lines 15-67); and

the mobile station using said access parameter to restrict the access of the mobile subscriber only to the first and/or the second network (col. 6, lines 49-67, col. 8, lines 6-20, col. 7, lines 20-30). Josse et al does not specifically teach a subscriber-specific access parameter.

In an analogous art, Bertacchi teaches a subscriber-specific access parameter (col. 3, lines 22-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Josse et al by specifically adding features in order to enhance a subscriber-specific access parameter to increasing the efficiency of the communication system for registry procedure as taught by Bertacchi.

Regarding claim 3 Josse et al teaches the mobile subscriber's access can be restricted only to one network even though a short message service had been defined for the mobile subscriber (col. 15, lines 45-50, col. 16, lines 60-65).

Regarding claims 4-6 Josse et al teach wherein the network element that requested the mobile subscriber data uses said access parameter to prevent location updating in a network which the mobile subscriber is not entitled to use (col. 6, lines 15-35, col. 7, lines 22-60).

Regarding claims 7,11 Josse et al teach first network is a circuit-switch and second is packet-switched (col.6, lines 50-65, col. 11, lines 11-35).

Response to Arguments

6. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAWAR IQBAL whose telephone number is 703-306-3015.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **MARSHA BANKS-HAROLD**, can be reached at 703-305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2684 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Khawar Iqbal

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
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